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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/126, 505 09/24/93 ATKINSON

J. WILSON DIF

EXAMINER

WALSH, S

18N2/9403

ART UNIT

PAPER NUMBER

18

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1813

DATE MAILED:

04/03/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

 This application has been examined Responsive to communication filed on 1/17/95 and 1/22/96 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

**Part II SUMMARY OF ACTION**

1.  Claims 1-5, 8-20, 23-32 and 34 are pending in the application.

Of the above, claims 1-5, 10-20, 25-32 and 34 are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 8, 9, 23 and 24 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

**EXAMINER'S ACTION**

Art Unit: 1812

**Part III DETAILED ACTION**

1. The amendment filed 11/17/95 has been entered.

2. The responses filed 12/19/94 and 11/17/95 did not provide reasons for traversing  
5 the restriction and election of species requirement, and the responses were treated as  
having been made without traverse.

The restriction and election requirement is still deemed to be proper and is therefore  
made FINAL.

10 3. The amendment of claims 1 and 16 has deleted the elected subject matter, i.e.  
species "C" in the requirement set out in paragraph 2, Office Action mailed 6/14/94. The  
only claims reciting structural features identifiable as corresponding to the elected subject  
matter are claims 8, 9, 23 and 24. Accordingly, prosecution continues on the elected  
invention as embodied in these claims. Claims 1-5, 10-20, 25-32 and 34 are withdrawn  
15 from further consideration by the Examiner as being drawn to a non-elected invention.

20 4. The Form 1449 filed with the IDS of 1/22/96 is incomplete in several citations.  
The following references were considered, but Applicant is advised that a complete  
citation is needed in order to list these references on the front of any patent that might  
issue in this application: Liszewski (AR), Clemenza et al (AT), and McNearney et al (AS).  
Reference Capecchi (1989) AR has been lined through because no copy was found.

5. The drawings remain objected to for the reasons of record. Correction is required.

6. Claims 8, 9, 23 and 24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8, 9, 23 and 24 are indefinite because they depend upon non-elected claims; also, even when the independent claims are considered, claims 8, 9, 23 and 24 lack antecedent basis for their subject matter in the independent claims, said subject matter having been deleted by amendment.

10 7. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

15 A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

20 Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

25 Claim 9 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 30 of copending application Serial No. 08/210,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap: e.g. the instant claim recites changes at positions 114-121 that appear to be the same as in the copending claim.

Serial Number: 08/126,505

- 4 -

Art Unit: 1812

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. The claims are free of the prior art of record.

5

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Stephen Walsh whose telephone number is (703) 308-2957. The Examiner can normally be reached on Monday-Friday from 8:00AM to 4:00PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's 10 Supervisor, Garnette D. Draper, can be reached on (703) 308-4232.

Papers related to this application may be submitted to Group 1800 in Crystal Mall 1 by facsimile transmission, in conformity with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The FAX phone number for Art Unit 1812 is (703) 15 308-0294.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

20

*Stephen Walsh*

Stephen Walsh, Ph.D.  
Primary Examiner  
Group 1800

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SW  
30 April 1, 1996